IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Docket No. 402200)

In re the Application of:	**Customer No. 27717**
William R. Wells	
Serial No.: 09/491,899	Art Unit: 2165
Filed: January 27, 2000	Examiner: Mahmoudi
For: GAMING TERMINAL AND SYSTEM WITH BIOMETRIC IDENTIFICATION	

TO: MAIL STOP: Appeal Brief-Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY TO EXAMINER'S ANSWER

This is in reply to the Examiner's Answer mailed February 6, 2008.

The Examiner's "Claim Rejections" on page 3-14 of the Examiner's Answer are identical to the Examiner's "Claim Rejections" on pages 6-17 of the final rejection mailed January 11, 2007. Pages 14-20 of the Examiner's Answer contain the Examiner's response to Appellant's arguments presented in the Appeal Brief. It is submitted that the Examiner's rejections and responses are without merit and do not support a holding of unpatentability.

For example, in Appellant's main brief, it is pointed out that Orus does not disclose a biometric smart card that stores biometric data for the player, or a reader which receives the biometric data stored on a smart card, or a biometric measurement device for measuring biometric data of a user to provide measured biometric data, or a comparator for comparing the measured biometric data to the biometric data stored on

the smart card, or the step of outputting an authorization allowing the player to access his or her account if there is a match. **The Examiner admits that all of these elements are missing from Orus.** Applicant's main brief also points out how the card system of Orus is an entirely numerical system in which numerical card identification numbers and balance values stored in the card are compared with a database to certify the data exchanged and to check the integrity of the system. This of course is completely different from Appellant's system and the Examiner has totally ignored this. Thus, it should be accepted as uncontested that Orus discloses an entirely numerical system, in which numerical card identification numbers and balance values stored on a card are compared with a database to certify the data exchanged and to check the integrity of the system.

While the differences between Orus and Appellant's are overwhelming, the Examiner has attempted to use Soltesz to remedy the significant deficiencies of Orus. As pointed out by Appellant, there is no teaching in Soltesz of the use of a system with gaming machines. The Examiner responds to this by merely stating that "there is nothing in Soltesz that indicates the invention cannot be used in gaming machines." (p. 15). However, the fact that Soltesz does not specifically disclose that it cannot be used in gaming machines is a far cry from teaching of the use of Soltesz's system in gaming machines. As pointed out in Appellant's main brief, gaming machines are significantly different from the purposes to which Soltesz is directed: Soltesz is used only for machines where an exact, expected service or product is provided to the user. For example, the Soltesz system requires receipt of an airline ticket, a precise amount of cash, etc. In a gaming machine, the outcome is random and uncontrolled. The

Examiner appears to erroneously consider the random and uncontrolled output of a gaming machine to be equivalent to a known outcome (p. 15).

On page 16 of the Examiner's Answer, the Examiner continues to apply Soltesz to a gaming environment on the ground that "there is nothing in Soltesz that excludes or prevents the gaming industry from using the teachings of his invention." The Examiner misses the point. The question is whether it would have been obvious to one having ordinary skill in the gaming art to use the teachings of Soltesz, and the Examiner has utterly failed to show why it would have been obvious to use the teachings of Soltesz in a gaming system.

On page 17 of the Examiner's Answer, the Examiner attempts to state why Orus and Soltesz are combinable, but it is clear that the combination only results from the use of hindsight after reading Appellant's own disclosure. The Examiner recognizes the convenience and excellent results of the combination, but that is based on Appellant's specification, nothing that is taught by the references themselves.

As stated in Appellant's main brief, Orus discloses a central processing unit that **has a database** that in parallel stores the data representing gambling operations carried out. As pointed out in Appellant's main brief, this parallel storing of card identification data teaches away from the concept of Soltesz in which the biometric card identification data is only stored on the card. On page 18 of the Examiner's Answer, the Examiner mistakenly argues that the parallel storage of card identification data "by Soltesz" (apparently the Examiner meant to state "by Orus") does not teach away from the combination of the two references. The Examiner states that the parallel storing of data provides additional security. But the Examiner's argument misses the point that

while Orus discloses parallel storing of card identification data **in a database**, this is totally contrary to Appellant's invention which is purposely meant to avoid the use of a separate database.

In paragraphs bridging pages 18 and 19, the Examiner then attempts to say that Soltesz also teaches parallel storage of information. However, the offsite storage device referred to in Soltesz is purely for storing application programs, and it has nothing to do with player identification data. Thus, any argument that Orus and Soltesz are similar in that they both teach parallel storage of player identification data completely fails. Appellant's claims very clearly call for biometric data of a user on a portable biometric smart card with the comparator comparing measured biometric data of the player to the biometric data stored in the smart card. It is uncontestable that this is not disclosed by Orus. The Examiner has not found anything in Soltesz that would enable Soltesz to be combined with Orus in a way that teaches Appellant's novel invention.

As pointed out on page 8 of Appellant's main brief, claims 8 and 24 include the step of storing personal preference data for the player in the smart card. On pages 19 to 20 of the Examiner's Answer, the Examiner attempts to respond to this by stating that Orus teaches storing "information on the gambler" and the credit amount that "the gambler desires." However, Orus' "information on the gambler" relates to the **identification** of the gambler - - not to the player's "personal preference data," as claimed. Likewise, the amount of credit stored is not the player's "personal preference data" as claimed.

Orus' "identification of the gambler" may include the gambler's age, gambling habits for gambler loyalty applications, awarding free games, etc." (Orus ¶54). However, personal preferences data of the gambler, (as stated on page 5 of Appellant's specification, lines 27-28) refers to "indications of types of games, drinks, entertainment and the like preferred, food, smoking/nonsmoking preferences, preferred machine denominations and the like." This is not taught by Orus.

Appellant has provided an important advance in the gaming device industry. It enables a player, who does not want his or her biometric data to be stored in a database, to have access to a gaming machine that is authorized on a match of the player's biometric data as measured against biometric data that is stored on a smart card. The need to store the player's biometric data in a database associated with a gaming machine is obviated. The Examiner's rejections over Appellant's claims are based on a combination of references that is improper and the Board is urged to reverse the Examiner's rejections.

Respectfully submitted,

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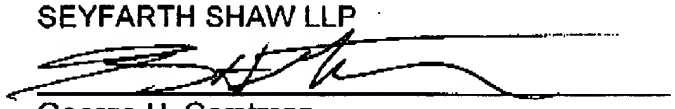

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I hereby certify that this correspondence is being sent Via Facsimile to the U.S. Patent and Trademark Office (Fax No. 571-273-8300) on Feb. 28, 2008.

Registered Attorney for Applicant
Date: Feb. 28, 2008